

**REMARKS**

**Summary Of The Office Action & Formalities**

Claims 1-15 are all the claims pending in the application. By this Amendment, Applicant is amending claims 1, 3, and 11-13, and adding new claim 16. No new matter is added.

Claims 1 and 11-13 are objected to for the minor reasons stated at page 2 of the Office Action. Applicant is amending the claims to overcome this objection.

Claims 3-10 are rejected under 35 U.S.C. § 112, second paragraph, for the reason set forth at page 2 of the Office Action. Applicant is amending the claims to overcome this rejection.

The prior art rejections are summarized as follows:

1. Claims 1-4, 9 and 11-13 are rejected under 35 U.S.C. § 102(b) as being anticipated by Feingold et al. (USP 5,772,666).
2. Claims 7-8 and 14-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Feingold et al. (USP 5,772,666).
3. Claims 14-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Feingold et al. in view of Blake (USP 6,280,449).

Applicant respectfully traverses.

**Claim Rejections - 35 U.S.C. § 102**

1. *Claims 1-4, 9 And 11-13 In View Of Feingold et al. (USP 5,772,666).*

In rejecting claims 1-4, 9 and 11-13 in view of Feingold et al. (USP 5,772,666), the grounds of rejection state:

Feingold et al. disclose a one-piece lens injecting apparatus or device 10 having a syringe body 12 with a piston 18, a cylindrical portion 12a containing a preloaded lens in an undeformed state, a conical intermediate portion 12b and an injection endpiece 24 wherein an injection end of the piston 18 has a plurality of paddles or fingers 22n that bear against the curved inside walls of syringe body 12 (Figures 1 and 16; col. 2, lines 23-36 and lines 45-56; col. 6, lines 1-30; col. 7, lines 37-41 and col. 9, lines 25-34).

Office Action at page 3.

Applicant has amended claim 1 by adding the subject matter of claim 3 that specifies that the plurality of fingers forms together a cylinder that occupies practically the entire section of an end of the body after they flex towards one another.

Feingold et al. discloses a scraper 22 which can be made of separate paddles. The object of these paddles is to scrap against the inner wall of the delivery passageway, as explained at column 9, lines 25-35, in order to maintain the trailing haptic away from the inner wall. Thus, these paddles are permanently urged against the wall and spaced apart in order to avoid the creation of a space between the ends of the scraper and the inner wall of the delivery passageway. As explained at column 5, lines 38-46 of the reference, this wiping contact prevents the trailing haptic of the deformable lens from being caught between the plunger tip (in this case, the paddles tips) and the delivery passageway.

In Applicant's invention, on the other hand, as explained at page 2, lines 14-16, the action of the plurality of fingers allows the stabilization of the orientation of the lens. Then, at the end of the thrust, the fingers will form a cylinder that occupies practically the entire section of the body. These technical features are not taught or suggested in Feingold et al., since the paddles according to this reference are two in number and these two paddles are located around the lens

such that the lens always remains between these two paddles. The tips of these paddles slide against the inner wall, around the trailing haptic of the lens. They are not used to push the lens, this action being realized by the V-surface formed by the two paddles. Consequently, these paddles can not occupy practically the entire section of the delivery passageway. If they did, the trailing haptic of the lens would be trapped between these paddles, and the lens would not be ejected. Even in this situation, the section of the body would be occupied by the two paddles and the trailing haptic, and not only by the two paddles as recited in amended claim 1.

Moreover, the subject matter of claim 1 is unobvious, the structures and the operation of the piston according to Feingold et al. being totally different from the piston of the present invention.

Therefore, claim 1 is believed to be allowable over the applied art, the technical features noted above not being taught or suggested in Feingold et al. Accordingly, the Examiner is kindly requested to reconsider and allow this claim and its dependent claims.

**Claim Rejections - 35 U.S.C. § 103**

*1. Claims 7-8 And 14-15 In View Of Feingold et al. (USP 5,772,666).*

In rejecting claims 7-8 and 14-15 in view of Feingold et al. (USP 5,772,666), the grounds of rejection state:

Regarding claim 7, the use of sealing gaskets or stoppers is well known in the art for the purpose of sealing fluid-filled syringes (refer cited art in the conclusion). Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a sealing gasket and a stopper in the Feingold et al. device since it was known in the art to provide these structures in a fluid-filled syringe for the purpose of sealing or containment.

Regarding claim 8, Feingold et al. disclose that device 10 can be manufactured from structural grade plastic or metal to allow autoclaving thereof (col. 10, lines 34-37). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the Feingold et al. device of materials capable of withstanding heat, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use, sterile use by autoclaving, as a matter of obvious design choice. *In re Leshin* 125 USPQ 416.

Regarding claims 14 and 15, Feingold et al. discloses two paddles or fingers 22n (col. 12, lines 1-2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided three fingers, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Office Action at pages 3-4.

Without agreeing to or substantively commenting on the grounds of rejection of claims 7, 8, 14, and 15, these claims are believed to be allowable at least by reason of their respective dependencies.

*2. Claims 14-15 Over Feingold et al. in view of Blake (USP 6,280,449).*

In rejecting claims 14-15 over Feingold et al. in view of Blake (USP 6,280,449), the grounds of rejection state:

Regarding claims 14 and 15, Feingold et al. disclose two paddles or fingers 22n (col. 12, lines 1-2).

Blake teaches a lens-injecting device with a pusher element or “plunger” or “piston” 14 with at least two push-blades of “fingers” to facilitate passage of an intraocular lens through a conical sleeve 20 (Figure 1 col. 2, lines 37- 46, col. 8, lines 9-15 and lines 44-59 and col. 12, lines 1-2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided three fingers, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Office Action at page 4.

Without agreeing to or substantively commenting on the grounds of rejection of claims 14 and 15, these claims are believed to be allowable at least by reason of their respective dependencies.

**Allowable Subject Matter**

Claims 5, 6 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. § 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims in independent form including all of the limitations of the base claim and any intervening claims. Applicant is holding in abeyance rewriting claim 5 in independent form.

**New Claim**

For additional coverage merited by the scope of Applicant's invention, Applicant is adding new claim 16, which is believed to be allowable because the applied art does not teach or suggest fingers that, after flexing towards one another, are brought together so as to occupy practically the entire section of the body.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

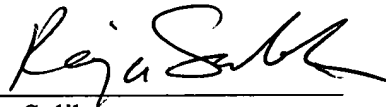
AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Application No. 09/890,832

Attorney Docket No.: Q65738

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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